

B&B-135

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: DAVID RAAB ET AL. Serial No.: 10/539,208 Filed: June 17, 2005 For: METHOD AND DEVICE FOR OPTIMIZING A NUCLEOTIDE SEQUENCE FOR THE PURPOSE OF EXPRESSION OF A PROTEIN	Art Unit: Unknown Examiner: Not Yet Assigned
---	---

**RESPONSE TO NOTICE TO FILE MISSING REQUIREMENTS
UNDER 35 U.S.C. 371 IN THE DO/EO/US**

Box: Missing Parts
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Notification of Missing Requirements Under 35 U.S.C. 371 In The United States Designated/Elected Office (DO/EO/US) mailed March 13, 2006, copy attached, applicants are submitting herewith:

- ☒ Declaration and Power of Attorney for Patent Application signed by Applicant;
- ☐ _____ sheets of drawings in compliance with applicable regulations;
- ☒ Other: Petition for a One-Month Extension of time to Respond to the Notification of Missing Requirements; Supplemental Preliminary Amendment Accompanying the Filing of a Sequence Listing; Sequence Listing; Statement Regarding Sequence Listing Pursuant to 37 CFR §1.821; Diskette containing the "Computer Readable Form" of the Sequence Listing.

Serial No.: 10/539,208
Art Unit: Unknown
Inventor: David RAAB et al.

Attorney's Docket No.: B&B-135
Page 2

- ☐ Check in the amount of _____ to cover the required fees for submission of these documents;
- ☒ The Commissioner is hereby authorized to charge the amount of \$125 to Deposit Account 03-3975 to cover the required fees for submission of these documents, and a copy of this authorization is attached.

Applicants wish to bring to the attention of the Office that a Preliminary Amendment was filed along with the present application on June 17, 2005. This Preliminary Amendment revised the claims to remove the multiple dependencies as filed. A copy of this Preliminary Amendment is resubmitted herewith for the convenience of the Office. Also enclosed herewith is a copy of the stamped postcard showing receipt of the application and attachments as filed on June 17, 2005 and the Application Transmittal Sheet showing that the "Box" for the Preliminary Amendment was checked and therefore submitted. Hence, applicants believe that the additional claim fee of \$360 is not required.

Finally, Applicants wish to state Assignee GeneArt AG employees less than 500 employees and therefore qualifies for small entity status. Accordingly, Applicants are submitting herewith small entity fees. Entry of Applicants' small entity status into the Office records and notification thereof is earnestly requested.

The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication or credit any overpayment to Deposit Account 03-3975.

It is respectfully submitted that the application is now complete and it is respectfully requested that the subject application be placed upon the files for examination.

Serial No.: 10/539,208
Art Unit: Unknown
Inventor: David RAAB et al.



Attorney's Docket No.: B&B-135
Page 3

PILLSBURY WINTHROP SHAW PITTMAN LLP
1650 Tysons Boulevard
McLean, VA 22102
Tel: 703/770-7900

Respectfully submitted,

DAVID RAAB ET AL.

Date: May 24, 2006

By: 
Michael Bednarek
Registration No. 32,329 
Reg. No. 43,741
Julie E. Cohen

MB/JEC/ggb

Customer No. 00909



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
10/539,208	David Raab	B&B-135

INTERNATIONAL APPLICATION NO.	
PCT/EP03/14850	
I.A. FILING DATE	PRIORITY DATE
12/23/2003	12/23/2002

28970
 PILLSBURY WINTHROP SHAW PITTMAN LLP
 1650 TYSONS BOULEVARD
 MCLEAN, VA 22102

CONFIRMATION NO. 2327

371 FORMALITIES LETTER



OC000000018233425

Date Mailed: 03/13/2006

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as a Designated / Elected Office (37 CFR 1.495).

- Copy of the International Application filed on 06/17/2005
- English Translation of the IA filed on 06/17/2005
- Request for Immediate Examination filed on 06/17/2005
- U.S. Basic National Fees filed on 06/17/2005
- Priority Documents filed on 06/17/2005

The applicant needs to satisfy supplemental fees problems indicated below.

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Additional claim fees of **\$360** as a non-small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due.
- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date.
- To avoid abandonment, a surcharge (for late submission of filing fee, search fee, examination fee or oath or declaration) as set forth in 37 CFR 1.492(h) of \$130 for a non-small entity, must be submitted with the missing items identified in this letter.

SUMMARY OF FEES DUE:

Total additional fees required for this application is **\$490** for a Large Entity:

- **\$130 Surcharge.**

- This application clearly fails to comply with the requirements of 37 CFR. 1.821-1.825. Applicant's attention is directed to the final rulemaking notice published at 55 FR 18230 (May 1, 1990), and 1114 OG 29 (May 15, 1990). If the effective filing date is on or after July 1, 1998, see the final rulemaking notice published at 63 FR 29620 (June 1, 1998) and 1211 OG 82 (June 23, 1998). If the effective filing date is on or after September 8, 2000, see the final rulemaking notice published in the Federal Register at 65 FR 54604 (September 8, 2000) and 1238 OG 145 (September 19, 2000). Applicant must provide an initial computer readable form (CRF) copy of the "Sequence Listing", an initial paper or compact disc copy of the "Sequence Listing", **as well as an amendment specifically directing its entry into the application.** Applicant must also provide a statement that the content of the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b), or 1.825(d). If applicant desires the sequence listing in the instant application to be identical with that of another application on file in the U.S. Patent and Trademark Office, such request in accordance with 37 CFR 1.821(e) may be submitted in lieu of a new CRF.
- A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 CFR 1.821(e). If the effective filing date is on or after September 8, 2000, see the final rulemaking notice published in the Federal Register at 65 FR 54604 (September 8, 2000) and 1238 OG 145 (September 19, 2000). Applicant must provide an initial computer readable form (CRF) copy of the "Sequence Listing" and a statement that the content of the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b), or 1.825(d). If applicant desires the sequence listing in the instant application to be identical with that of another application on file in the U.S. Patent and Trademark Office, such request in accordance with 37 CFR 1.821(e) may be submitted in lieu of a new CRF.

- Total additional claim fee(s) for this application is \$ 360

- \$360 for multiple dependent claim surcharge.

Applicant is cautioned that correction of the above items may cause the specification and drawings page count to exceed 100 pages. If the specification and drawings exceed 100 pages, applicant will need to submit the required application size fee.

For questions regarding compliance to 37 CFR 1.821-1.825 requirements, please contact:

- For Rules Interpretation, call (571) 272-0951
- For Patentin Software Program Help, call Patent EBC at 1-866-217-9197 or directly at 703-305-3028 / 703-308-6845 between the hours of 6 a.m. and 12 midnight, Monday through Friday, EST.
- Send e-mail correspondence for Patentin Software Program Help @ ebc@uspto.gov

ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 32 MONTHS FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

*A copy of this notice **MUST** be returned with the response.*

LAMONT M HUNTER

Telephone: (703) 308-9140 EXT 201

PART 1 - ATTORNEY/APPLICANT COPY

U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
10/539,208	PCT/EP03/14850	B&B-135

FORM PCT/DO/EO/905 (371 Formalities Notice)

B&B-135

**TRANSMITTAL LETTER TO THE UNITED STATES
DESIGNATED/ELECTED OFFICE (DO/EO/US)
CONCERNING A SUBMISSION UNDER 35 U.S.C. 371**

U.S. APPLICATION NO. (If known, see 37 CFR 1.5)

INTERNATIONAL APPLICATION NO.
PCT/EP2003/014850

INTERNATIONAL FILING DATE
23 DECEMBER 2003 (23.12.2003)

PRIORITY DATE CLAIMED
23 DECEMBER 2002 (23.12.2002)

TITLE OF INVENTION

METHOD AND DEVICE FOR OPTIMIZING A NUCLEOTIDE SEQUENCE FOR THE PURPOSE OF EXPRESSION OF A PROTEIN

APPLICANT(S) FOR DO/EO/US

RAAB, David; GRAF, Marcus; NOTKA, Frank; and WAGNER, Ralf

Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:

1. ☒ This is a **FIRST** submission of items concerning a submission under 35 U.S.C. 371.
2. ☐ This is a **SECOND** or **SUBSEQUENT** submission of items concerning a submission under 35 U.S.C. 371.
3. ☒ This is an express request to begin national examination procedures (35 U.S.C. 371(f)). The submission must include items (5), (6), (9) and (24) indicated below.
4. ☒ The US has been elected (Article 31).
5. ☒ A copy of the International Application as filed (35 U.S.C. 371 (c)(2)).
 - a. ☒ is attached hereto (required only if not communicated by the International Bureau).
 - b. ☐ has been communicated by the International Bureau.
 - c. ☐ is not required, as the application was filed in the United States Receiving Office (RO/US).
6. ☒ An English language translation of the International Application as filed (35 U.S.C. 371(c)(2)).
 - a. ☒ is attached hereto.
 - b. ☐ has been previously submitted under 35 U.S.C. 154(d)(4).
7. ☒ Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371 (c)(3))
 - a. ☐ are attached hereto (required only if not communicated by the International Bureau).
 - b. ☐ have been communicated by the International Bureau.
 - c. ☐ have not been made; however, the time limit for making such amendments has NOT expired.
 - d. ☒ have not been made and will not be made.
8. ☐ An English language translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)).
9. ☒ An oath or declaration of the inventor(s) (35 U.S.C. 371 (c)(4)).
10. ☐ An English language translation of the annexes to the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371 (c)(5)).
11. ☐ A copy of the International Preliminary Examination Report (PCT/IPEA/409).
12. ☒ A copy of the International Search Report (PCT/ISA/210).

Items 13 to 23 below concern document(s) or information included:

13. ☐ An Information Disclosure Statement under 37 CFR 1.97 and 1.98.
14. ☐ An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.
15. ☒ A **FIRST** preliminary amendment.
16. ☐ A **SECOND** or **SUBSEQUENT** preliminary amendment.
17. ☐ A substitute specification.
18. ☐ A power of attorney and/or change of address letter.
19. ☐ A computer-readable form of the sequence listing in accordance with PCT Rule 13ter.2 and 37 CFR 1.821 - 1.825.
20. ☐ A second copy of the published International Application under 35 U.S.C. 154(d)(4).
21. ☐ A second copy of the English language translation of the International Application under 35 U.S.C. 154(d)(4).
22. ☐ Express Mail Label No.
23. ☒ Other items or information:

ACKNOWLEDGMENT POSTCARD

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

U.S. APPLICATION NO (if known, see 37 CFR 1.5)		INTERNATIONAL APPLICATION NO. PCT/EP2003/014850		ATTORNEY'S DOCKET NUMBER B&B-135	
24. The following fees are submitted:				Applicant use	Office use
<input checked="" type="checkbox"/> a) Basic national fee \$300.00				\$ 300.00	
<input checked="" type="checkbox"/> b) Examination fee \$200.00				\$ 200.00	
<input checked="" type="checkbox"/> c) Search fee \$500.00				\$ 500.00	
TOTAL OF ABOVE CALCULATIONS = \$1000.00				\$ 1,000.00	
<input type="checkbox"/> Additional fee for specification and drawings filed in paper over 100 sheets (excluding sequence listing or computer program listing filed in an electronic medium). The fee is \$250 for each additional 50 sheets of paper or fraction thereof.					
Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof (round up to a whole)		RATE	
- 100 =	/50 =			x	\$
Surcharge of \$130.00 for furnishing the oath or declaration later than months from the earliest claimed priority date (37 CFR 1.492(e)).				\$	
CLAIMS	NUMBER FILED	NUMBER EXTRA	RATE		
Total claims	30 - 20 =	10	x	\$50.00	\$ 500.00
Independent claims	2 - 3 =	0	x	\$200.00	\$ 0.00
MULTIPLE DEPENDENT CLAIMS (if applicable) <input type="checkbox"/> +				\$	\$0.00
TOTAL OF ABOVE CALCULATIONS =				\$	\$1,500.00
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. The fees indicated above are reduced by 1/2.				\$	\$0.00
SUBTOTAL =				\$	\$1,500.00
Processing fee of \$130.00 for furnishing the English translation later than 30 months from the earliest claimed priority date (37 CFR 1.492(f)).				\$	\$0.00
TOTAL NATIONAL FEE =				\$	\$1,500.00
Fee for recording the enclosed assignment (37 CFR 1.21(h)). The assignment must be accompanied by an appropriate cover sheet (37 CFR 3.28, 3.31). \$40 per property +				\$	\$0.00
TOTAL FEES ENCLOSED =				\$	\$1,500.00
Amount to be refunded:				\$	
Amount to be charged:				\$	
<p>a. <input checked="" type="checkbox"/> A check in the amount of \$ 1,350.00 to cover the above fees is enclosed.</p> <p>b. <input checked="" type="checkbox"/> Please charge my Deposit Account No. 50-1390 in the amount of \$150.00 to cover the above fees. A duplicate copy of this sheet is</p> <p>c. <input checked="" type="checkbox"/> The Director is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-1390. A duplicate copy of this sheet is enclosed.</p> <p>d. <input type="checkbox"/> Fees are to be charged to a credit card. WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</p>					
NOTE: Where an appropriate time limit under 37 CFR 1.495 has not been met, a petition to revive (37 CFR 1.137(a) or (b)) must be filed and granted to restore the International Application to pending status.					
SEND ALL CORRESPONDENCE TO:					
MICHAEL BEDNAREK					
REG. NO. 32,329					
PILLSBURY WINTHROP SHAW PITTMAN LLP					
1650 TYSONS BOULEVARD					
MCLEAN, VA 22102					
				SIGNATURE	
				MICHAEL BEDNAREK	
				NAME	
				32,329	
				REGISTRATION NUMBER	

PLEASE STAMP AND RETURN TO SHOW RECEIPT OF:

24283.0131

New U.S. Patent Application of DAVID RAAB ET AL.

For: METHOD AND DEVICE FOR OPTIMIZING A NUCLEOTIDE SEQUENCE FOR THE PURPOSE OF
EXPRESSION OF A PROTEIN

ATTN: BOX PATENT APPLICATION

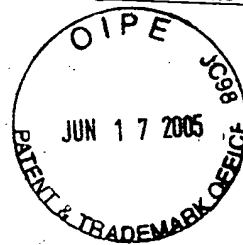
- ☒ Check in the amount of \$1,350.00 or ☒ Authorization to charge Deposit Account 50-1390 \$150
- ☒ Transmittal Letter
- ☒ Specification of 79 pages: 70 pages description, 8 page(s) claims (for claims 1-30) and 1 page abstract
- ☒ Declaration and Power of Attorney (unexecuted)
- ☒ Drawings - 13 sheets - 20 total figures
- ☐ Recordation Form Cover Sheet
- ☐ Assignment
- ☒ Preliminary Amendment
- ☐ Information Disclosure Statement
- ☐ PTO-1449, _____ reference(s)
- ☒ Other: Copy of original application PCT/EP2003/014850; 3 sheets of sequence listing; Certificate of Translation

Due Date: 06/23/05

Dated: June 17, 2005

Attorney Docket No.: B&B-135

MB/ggb



JC04 Rec'd PCT/PTO 17 JUN 2005

PLEASE STAMP AND RETURN TO SHOW RECEIPT OF:

24283.0131

New U.S. Patent Application of DAVID RAAB ET AL.

10/539208

For: METHOD AND DEVICE FOR OPTIMIZING A NUCLEOTIDE SEQUENCE FOR THE PURPOSE OF
EXPRESSION OF A PROTEIN

ATTN: BOX PATENT APPLICATION

- ☒ Check in the amount of \$1,350.00 or ☒ Authorization to charge Deposit Account 50-1390 \$150
- ☒ Transmittal Letter
- ☒ Specification of 79 pages: 70 pages description, 8 page(s) claims (for claims 1-30) and 1 page abstract
- ☒ Declaration and Power of Attorney (unexecuted)
- ☒ Drawings - 13 sheets - 20 total figures
- ☐ Recordation Form Cover Sheet
- ☐ Assignment
- ☒ Preliminary Amendment
- ☐ Information Disclosure Statement
- ☐ PTO-1449, _____ reference(s)
- ☒ Other: Copy of original application PCT/EP2003/014850; 3 sheets of sequence listing; Certificate of Translation

RECEIVED
JUL 06 2005
PILLSBURY WINTHROP SHAW PITTMAN LLP

Due Date: 06/23/05

Dated: June 17, 2005

Attorney Docket No.: B&B-135

MB/ggb